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EXAMINER

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/729,742
Filing Date: December 05, 2003
Appellant(s): GRIFFIN ET AL.

David M. Crompton
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 02/13/2008 appealing from the Office action mailed 09/17/2008.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

No amendment after final has been filed.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

6,873,868	Furnish	03/29/2005
5,327,891	Rammler	07/12/1994
6,210,396	MacDonald et al.	04/03/2001

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

1. Claims 1-7, 9, 14-15, 18, and 21 are rejected under 35 U.S.C. 102(e) as being anticipated by Furnish (US 6,873,868 B2).
2. For claims 1-6, 9, 14, 18, and 21, Furnish discloses a catheter (120) (as best seen in Figure 7), comprising:

- an elongate shaft (122) having a proximal region (the right-most region of the device seen in Figure 7), a distal region (the left-most region of the device seen in Figure 7), an exterior surface (126) extending therebetween (as best seen in Figure 7), and a lumen (136) extending therebetween (as best seen in Figure 7);
- an anchoring means for securing the removable support means comprising a plurality of support tracks (124) (as best seen in Figures 1A-1C) disposed on the external surface of the elongate shaft, the support tracks being axially aligned with the elongate shaft (as best seen in Figures 1A-1C), and the support tracks integrally extruded with the elongate shaft (as best seen in Figures 1A-1C);
- a removable support means for providing column support to the elongate shaft comprising a plurality of support ribs (130) (as best seen in Figure 7) disposed over at least a portion of the exterior surface of the elongate shaft (as best seen in Figure 7) and configured to be removably disposed over at least a portion of the plurality of support tracks via axial sliding (column 8 lines 33-37); and
- wherein the anchoring means for securing the removable support means has a cross-sectional profile configured to permit the removable support means to move axially with respect to the elongate shaft while limiting relative radial movement (column 8 lines 33-37) (as best seen in Figures 1A-1C) and complementary to the cross-section profile of each of the plurality of support tracks (column 8 lines 33-37) (as best seen in Figures 1A-1C), and
- wherein the distal region of the elongate shaft includes a distal end (the left-most tip of the device seen in Figure 7), and the anchoring means for securing the removable

support means comprising the plurality of support tracks extends from a position proximate the proximal region of the elongate shaft to a position proximal of the distal end of the elongate shaft (as best seen in Figure 7).

3. For claims 7 and 15, Furnish discloses a catheter (120), wherein the anchoring means for securing the removable support means comprising the plurality of support tracks comprises four support tracks that are axially aligned along the elongate shaft and disposed such that each support is radially equidistantly spaced around the radius of the elongate shaft (as best seen in Figure 7).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 11-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Furnish in view of Rammler (US 5,327,891). Furnish discloses the claimed invention except for expressly disclosing the plurality of support tracks having a cross-section profile, comprising: an ovoid cross-section having a minor dimension perpendicular to the exterior surface of the elongate surface and a major dimension perpendicular to the minor dimension, wherein the major dimension varies as a function of distance from the exterior surface of the elongate shaft, and wherein the major dimension is minimized at

a position proximate the exterior surface of the elongate shaft and is maximized at a position radially displaced from the exterior surface a distance equal to or less than the minor dimension. Rammler teaches a catheter (80) with a plurality of support tracks (82 and 94) having a cross-section profile, comprising: an ovoid cross-section having a minor dimension perpendicular to the exterior surface of the elongate surface and a major dimension perpendicular to the minor dimension, wherein the major dimension varies as a function of distance from the exterior surface of the elongate shaft, and wherein the major dimension is minimized at a position proximate the exterior surface of the elongate shaft and is maximized at a position radially displaced from the exterior surface a distance equal to or less than the minor dimension (as best seen in Figure 4). It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the catheter as taught by Furnish, with the catheter as taught by Rammler for the purpose of configuring the geometry of a catheter support track for increased patient safety by structuring the catheter in a manner conducive to traversing bodily vasculature.

5. Claims 16 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Furnish in view of MacDonald et al (US 6,210,396, hereinafter MacDonald).

Furnish discloses the claimed invention except for expressly disclosing attaching a portion of a catheter device by heat bonding or adhesives. MacDonald teaches attaching a portion of the catheter by using either heat bonding or adhesives (column 9 lines 58-60). It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the catheter as taught by Furnish, with the

catheter as taught by MacDonald for the purpose configuring the material properties of a catheter support for increased patient safety by structuring the catheter in a manner conducive to traversing bodily vasculature.

6. Claims 19-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Furnish in view of Rammler. Furnish discloses the claimed invention except for expressly disclosing the plurality of support ribs comprising a fluorinated polyethylene polymer and specifically polytetrafluoroethylene. Rammler teaches a catheter (80) with a plurality of support ribs (86 for example) comprising a fluorinated polyethylene polymer and specifically polytetrafluoroethylene (column 3 lines 21-23). It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the catheter as taught by Furnish, with the catheter as taught by Rammler for the purpose of configuring the material properties of a catheter support for increased patient safety by structuring the catheter in a manner conducive to traversing bodily vasculature.

(10) Response to Argument

7. As an initial matter to simply the issues on Appeal, the Examiner vacates paragraph 11 of the Final Office Action mailed 09/17/08, thus the claimed limitations of at least claims 1 and 2 comprising means-plus-function limitations invoking 35 U.S.C. 112 Sixth paragraph have been treated on the merits as such. With regards to Appellant's arguments thereagainst (see pages 7-8 of the Appeal Brief filed 02/13/08) the Examiner notes the arguments are moot.

8. Appellant's arguments in the Appeal Brief filed 02/13/08 have been fully considered but they are not persuasive. Appellant argues the anticipatory rejections of claims 1-7, 9, 14-15, 18, and 21 under Furnish (see Appeal Brief filed 02/13/08 pages 7-11), the obviousness rejection of claims 11-13 and 19-20 over Furnish in view of Rammler (see Appeal Brief filed 02/13/08 pages 11-14), and the obviousness rejection of claims 16 and 17 over Furnish in view of MacDonald (see Appeal Brief filed 02/13/08 pages 12-13). The Examiner disagrees, maintains the rejections, and notes in response the following:

9. For claims 1-7 and 9, Appellant argues the claimed limitations a "removable support means for providing column support to the elongate shaft" and an "anchoring means for securing the removable support means" as taught by Furnish fail to meet the requirements of 35 U.S.C. 112 Sixth paragraph, including performing the same function in substantially the same way while producing substantially the same result.

The "removable support means for providing column support to the elongate shaft" as cited above not only performs the same function in *substantially* the same way while producing *substantially* the same result, but is also capable of performing the same function in *substantially* the same way while producing *substantially* the same result, and in addition provides light. Regardless the cited structure of Furnish meets the claims as broadly as claimed and in light of 35 U.S.C. 112 Sixth paragraph, the "removable support means for providing column support to the elongate shaft" (130) (as best seen in Figure 7) as taught by Furnish not only function to "provide column(ar)

support to the elongate shaft” but are also capable of “provid(ing) column(ar) support to the elongate shaft”.

The “anchoring means for securing the removable support means” as cited above not only performs the same function in *substantially* the same way while producing *substantially* the same result, but is also capable of performing the same function in *substantially* the same way while producing *substantially* the same result. The cited structure of Furnish meets the claims as broadly as claimed and in light of 35 U.S.C. 112 Sixth paragraph, the “anchoring means for securing the removable support means” (124) (as best seen in Figure 7) as taught by Furnish not only function to “secure the removable support means” but are also capable of “secure(ing) the removable support means”.

In response to Appellant’s argument that “the removable support means for providing column support to the elongate shaft” is for providing column support to the elongate shaft and “the anchoring means” is for securing the removable support means, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In this case, the equivalent structure of Furnish not only performs the claimed functions, but is also capable of performing them as well.

10. Moreover, for claims 3 and 9, Appellant argues the claimed limitations “wherein the anchoring means (support tracks) have a cross-sectional profile configured to permit

the removable support means to move axially with respect to the elongate shaft while limiting relative radial movement". The Examiner notes as broadly as claimed Furnish anticipates the claim language because said language does not specify and/or positively recite the direction of the limited relative radial movement. As seen in Figure 7, the anchoring means of Furnish function to limit the relative radial movement of the removable support means in an inwardly radial direction.

Moreover the Examiner notes in response to Appellant's argument that the anchoring means or support tracks have a cross-sectional profile configured to permit the removable support means to move axially with respect to the elongate shaft while limiting relative radial movement, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. As best seen in Figure 1-3 and in this case, Furnish shows support tracks having a complementary cross-sectional profile to the support means, said cross-sectional profile capable of permitting the removable support means to move axially with respect to the elongate shaft while limiting relative radial movement.

11. For claims 11-13, Appellant argues Furnish in view of Rammler does not teach the claimed limitations (a) "wherein the cross-section profile comprises an ovoid cross-section" and (b) the cross-section profile does not limit relative radial movement. For (a) the Examiner notes, Rammler teaches the cross-sectional profile comprising an ovoid cross-section (column 3 lines 27-44). For (b), see paragraph 10 above.

12. For claims 16-17, Appellant argues Furnish in view of McDonald does not teach the claimed limitations “wherein the support tracks are heat bonded to the exterior of the surface of the elongate shaft” because there is no reasonable chance of success. In response to applicant's argument that Furnish in view of McDonald do not teach that the support tracks are heat bonded to the exterior of the surface of the elongate shaft, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In this case, Appellant is claiming the intended use of how the structure of the catheter is created, the Examiner notes that the catheter as taught by Furnish in view of McDonald is capable of being created by heat bonding.

13. For claims 19-20, Appellant argues there is no motivation to combine Furnish in view of Rammler to teach the claimed limitation wherein the plurality of support ribs comprise a fluorinated polyethylene polymer and specifically polytetrafluoroethylene. In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, both Furnish and Rammler

Art Unit: 3752

are concerned with and teach intravascular catheter devices wherein the devices are configured for traversing bodily vasculature and for increased patient safety.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

/Jeffrey G Hoekstra/
Examiner, Art Unit 3736

Conferees:

/Max Hindenburg/

Supervisory Patent Examiner, Art Unit 3736

/Heather Shackelford/

Heather Shackelford